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| 09/929,979 | 08/15/2001 | Noah J. Ternullo | 12078-141 | 2164 |
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| PERKINS, SMITH & COHEN LLP ONE BEACON STREET 30TH FLOOR BOSTON, MA 02108 | | | GANTT, ALAN T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2684 | |

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,979

Applicant(s)

TERNULLO ET AL.

Examiner

Alan T. Gantt

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21, 22 and 24-43 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 30305.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Response to Arguments***

Applicant's arguments filed 12/27/04 have been fully considered. Applicant has amended aspects of his claims. In claims 1 and 9, applicant has amended to indicate means for performing several functions within the transmitter sending a signal to a handset device. Applicant arguments against the Treyz reference are not persuasive since the handheld device of Treyz does receive the intended signal and the signal is presented to the user of the device as an advertisement or presented in a form of information on the display that exhibits certain unique qualities, Therefore the signal as presented to the handheld device display is sent and has cues or falls within a certain protocol in order to present the message in this certain manner. It was already established that the information presented to the device related to previously express interests of the user. Thus, the examiner feels that the previous rejection of claims 1 and 9 and their dependent claims still holds.

The examiner is in agreement with the applicant arguments regarding independent claims 25, 29, 37, and 41. Thus, these claims and all that depend from them are allowed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al.

Regarding claim 1, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz includes a transmitter / receiver for receiving an advertisement containing information from a service provider and for conveying said advertisement to a handheld device, said transmitter comprising

means for defining a context in said transmitter; (col. 23, lines 26-35: context meaning location)

means for receiving information at said transmitter; (col. 1, lines 45-48 and col. 38, lines 38-46)

means for formatting said advertisement into a machine-readable form to produce a transmitted signal compatible with said handheld device and relevant to said context; (col. 55, lines 30-40 – device displays advertisement, thus, formatting is inherently performed) and

means for conveying said transmitted signal from said transmitter to said handheld device located within said context, said information displayed to a user of said handheld device if said user has previously expressed an interest in said service. (col. 30, lines 3-21; col. 14, lines 14-40; col. 39, lines 6-62; col. 56, lines 46-51; and col., 54, lines 23-52)

Regarding claim 2, Treyz meets the limitation -The transmitter of claim 1 wherein said conveying means transmits a diffuse infrared signal. (col. 13, lines 10-15 and col. 30, lines 3-21)

Regarding claim 7, Treyz meets the limitation - The transmitter of claim 1 further comprising means for receiving a reply from said handheld device. (col. 20, line 57 to col. 22, line 15)

Regarding claim 9, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz includes a handheld device operating in a context associated with a transmitter / receiver conveying a transmitted signal, said handheld device comprising:

means for receiving said transmitted signal to form a received signal, said transmitted signal being formatted by the transmitter, said received signal containing an advertisement including information from a service provider offering a service, (col. 39, lines 6-62)

said received signal further being present if said handheld device is located within said context, said context being communicatively associated with said transmitter; and (col. 39, lines 6-62)

means for extracting said information if a user of said handheld device has expressed an interest in such a service. (col. 55, lines 31-40)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5, 8, and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al., in view of Aufricht et al.

Regarding claim 3, the examiner takes Official Notice that it is well known to utilize diffuse infrared signals with wavelengths of 850 nanometers to 1250 nanometers and that it would have been obvious for Treyz to utilize such devices since they are commonly available.

Regarding claim 4, the applicant's specification admits that the technique of diffuse infrared signals generated by modulating electric light is known in the art. (paragraph 0167)

Regarding claim 5, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services as stated above for claim 1.

However, Treyz is silent regarding information transmitter in the form of an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for

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placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufricht meets the following limitation:

The transmitter of claim 2 wherein said information in the form of an XML element. (paragraph 0033 and Table 1 [placing interactive advertisements from the Internet or Web content to mobile devices with XML beings one of the allowable forms])

Treyz and Aufricht are combinable because they share a common endeavor, namely handheld devices and commerce system that provide advertisements to the user. At the time of the applicant's invention it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

Regarding claims 8 and 10, the examiner takes Official Notice that it is well known to utilize plug-ins associated with interests and that it would have been obvious to modify the Treyz / Aufricht combination to include plug-ins to connect a desired user with the desired interest and filter out those that do not share the interest.

Regarding claim 11, Treyz meets the limitation - The handheld device of claim 9 wherein said transmitted signal is a diffuse infrared signal. (col. 13, lines 10-15 and col. 30, lines 3-21)

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Regarding claim 12, Treyz meets the limitation - The handheld device of claim 9 further comprising means for displaying at least a portion of said information to said user. (col. 10, lines 9-19)

Regarding claim 13, Treyz meets the limitation - The handheld device of claim 12 further comprising means for accepting an input from said user, said input provided in response to said at least a portion of said information. (col. 20, line 75 to col. 22, line 15)

Regarding claim 14, Aufricht meets the limitation -The handheld device of claim 9 wherein said transmitter further includes means for receiving a reply from said handheld device, said reply generated in response to said input. (paragraph 0232) [Also, Treyz – col. 41, lines 11-25)

Regarding claim 15, Aufricht meets the limitation - The handheld device of claim 9 wherein said information is comprised of a first XML element. (paragraph 0033 and Table 1 [placing interactive advertisements from the Internet or Web content to mobile devices with XML beings one of the allowable forms)

Allowable Subject Matter

Claims 21, 22 and 24-43 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claim 25, 29, 34, 37 and 41, a method and system for establishing a context of a user located within a coverage area associated with a transmitter that includes encapsulating a first XML element in a second XML element and converting the first XML element and the integrity element into a signal was neither found, suggested, nor made evident by the prior art. Further the examiner is in agreement with applicant in regards to these claims

Claims 6 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 6 and 16-18 information or an advertisement in the form of an XML element encapsulated within an integrity element was neither found, suggested, nor made evident by the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Alan Gantt at telephone number (703) 305-0077. The examiner can normally be reached between 9:30 AM and 6 PM within the Eastern Time Zone. The group FAX number is (703) 872-9306.

Any inquiry of a general nature or relating to this application should be directed to the group receptionist at telephone number (703) 305-4700.

Alan T. Gantt
Alan T. Gantt

May 28, 2005

Nick Corsaro
**NICK CORSARO
PRIMARY EXAMINER**